

REMARKS

I. Status of the Claims

Claims 30-53 are pending. Claims 47-53 have been withdrawn by the Examiner as being allegedly drawn to a non-elected invention. As such, only claims 30-46 have been examined. No claim is amended.

II. Information Disclosure Statement

Applicants note that the Examiner has not considered and initialed on the Form PTO-1449 document #17 (an article by Ram et al.) of the IDS filed 8/24/01. This article is in English and was submitted with the IDS, so it should have been considered. However, for the Examiner's convenience, Applicants enclose another copy of Ram et al. and ask the Examiner to consider it and return to Applicants an initialed Form PTO-1449 with the next Office Action.

III. Restriction Requirement

The Examiner has required restriction between the following groups of claims:

Group I Claims 30-46, drawn to a ready-to-use composition for the oxidation dyeing of keratin fibers, classified in class 8, subclass 406.

Group II Claims 47-50, drawn to a process of reshaping keratin fibers, classified in class 424, subclass 70.22.

Group III Claims 51-53, drawn to a process of bleaching keratin fibers classified in class 424, subclass 62.

The restriction requirement is respectfully traversed. To be responsive, however, Applicants affirm their election of the subject matter of Group I, claims 30-46, with traverse.

The Examiner bases the restriction on the grounds that “[t]he process of formulating a hair coloring composition as claimed could be used to make other and materially different product such as one used to reshape hair.” Office Action, page 2.

Applicants refer the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction. The M.P.E.P. instructs the Examiner as follows:

If the search and examination of an entire application can be made without serious burden, the Office must examine it on the merits, even though it includes claims to distinct or independent inventions.

M.P.E.P. § 803.

Since the claims in each group recite nearly identical ingredients (the enzyme, the donor and the anionic surfactant), there would not be a serious burden to search all three groups of claims.

The restriction requirement is also improper because it is not clear what the Examiner means when she refers to a “process of formulating a hair coloring composition.” Such a process is not claimed here. Finally, the classification of at least Group III appears to be improper; it should be classified in class 8/subclass 406 since that class/subclass includes both compositions and processes, and also includes bleaching and dyeing (see attached from the Classification Index).

Thus, for the above reasons, Applicants respectfully submit that the restriction requirement is in error and request that the requirement be withdrawn.

IV. Rejections Under 35 U.S.C. § 103(a)

Rejection Over Tomura et al.

The Examiner rejected claims 30-46 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent 6,207,719 to Tomura et al. (herein referred to as "Tomura"). Applicants respectfully traverse.

The present invention relates to a ready-to-use compositions for the oxidation dyeing of keratin fibers comprising (a) at least one 2-electron oxidoreductase enzyme, (b) at least one donor for the enzyme, (c) at least one anionic surfactant chosen from eight specific categories as set forth in, e.g., claim 30, and (d) at least one oxidation base. According to the Examiner, Tomura teaches an aqueous cosmetic composition and process for treating hair or skin which employs the enzyme uricase and uric acid as the donor, and can also contain anionic surfactants and oxidation dyes. Office Action, p.3.

The Examiner admits that Tomura does not teach the specific anionic surfactants required in Applicant's claimed invention, but alleges that (a) Applicant's claimed anionic surfactants and the claimed amounts fall within the scope of those taught by Tomura, and (b) optimization of the proportions would have obvious to obtain the most effective color development. *Id.* Applicants disagree.

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) the prior art reference(s) must teach or suggest all the claim limitations, (2) there must be some suggestion or motivation to modify the reference(s), and (3) there must

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be a reasonable expectation of success in doing so. See M.P.E.P. § 2143 and cases cited therein. These criteria have not been met here.

First, Tomura does not teach all the present claim limitations, at least because there is no teaching or suggestion of Applicants' specific anionic surfactants in Tomura. Tomura recites anionic surfactants generally, in a list of possible additives useful in its compositions. See col. 3, lines 41-52. No preferred anionic surfactants are disclosed, and even in the examples at col. 6-7, not one of the surfactants listed is anionic, let alone an anionic surfactant in one of the eight claimed categories. Thus, the Examiner has not pointed to a single anionic surfactant and has not recited a single anionic surfactant amount. How is it possible that Applicants' claimed, specific anionic surfactants and their amounts could "fall within the scope of those taught by Tomura," when Tomura has no such teaching or even a remote suggestion?

Further, Tomura provides no suggestion or motivation to modify its composition or include one of the presently claimed anionic surfactants. As held by the Federal Circuit, "[e]ven when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference." See *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d (BNA) 1314, 1318 (Fed. Cir. 1996). Here, the Examiner has failed to show any suggestion or motivation to choose Applicants' specific anionic surfactants, especially considering that Tomura does not teach or these surfactants. Such modification of the very general teachings of Tomura can hardly fall under the umbrella of obviousness.

Finally, the Examiner has provided no discussion of why, from the teaching of Tomura, one of ordinary skill in the art would have reasonably expected success if

Applicants' anionic surfactants were used in Tomura's composition. Tomura specifically notes at column 3, lines 50-52 that the optional additives listed therein (including surfactants) can be added "in so far as they do not adversely affect the present invention." The Examiner has pointed to absolutely nothing in the reference that would have guided one of ordinary skill in the art to choose surfactants that would not "adversely affect" the delicate balance of the Tomura composition. Tomura is drawn to the stable solubilization of uric acid, and admits that "in aqueous cosmetic compositions containing surfactants and polymers, no satisfactory technique for stably solubilizing uric acid has yet been found." Column 1, lines 51-53. Tomura further, discloses that acrylic polymers at a certain pH can stably solubilize uric acid. Thus, the choice of surfactant could in fact adversely affect such a carefully balanced solubilization system. Accordingly, unless the Examiner can point to a specific motivation in the reference to add one of the eight claimed types of anionic surfactants in Tomura's composition with reasonable expectation of success, she cannot establish a *prima facie* case.

Thus, as none of the three required elements needed to establish a *prima facie* case of obviousness as set forth in M.P.E.P. 2143 have been met, withdrawal of the rejection is respectfully requested.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Enclosures: -Additional Copy of Ram et al. (1995) Indian J. of Chem. Vol. 34B, pp.
514-520
-Copy of page from Classification Index

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CLASS 8 BLEACHING AND DYEING; FLUID TREATMENT AND CHEMICAL MODIFICATION OF TEXTILES AND FIBERS 8 - 1

400	MEASURING, TESTING, OR INSPECTING DYE PROCESS	439	.Logwood
401	USING ENZYMES, DYE PROCESS, COMPOSITION, OR PRODUCT OF DYEING	440	DYE RECOVERY PROCESS, OTHER THAN NOMINAL RECOVERY
402	WOOD DYEING PROCESS	441	PROCESS OF COLOR RENOVATING A DYED PRODUCT
403	FUGITIVE DYE COMPOSITION, PROCESS OR PRODUCT	442	COLOR PROTECTING PROCESS FOR DYED PRODUCT
404	DYEING INVOLVING ANIMAL-DERIVED NATURAL FIBER MATERIAL (OTHER THAN SOLELY WOOL OR SILK), E.G., LEATHER, FUR, HAIR, FEATHERS, ETC., COMPOSITION, PROCESS, OR PRODUCT	443	WEIGHTING PROCESS (LOADING SILK WITH METAL SALTS)
405	.Hair dyeing	444	DYEING PROCESS UTILIZING ELECTRIC, MAGNETIC, OR WAVE ENERGY; OR PRODUCT THEREOF
406	..Oxidation dye	445	PROCESS OF PRINTING PERMANENTLY ON SUBSTRATE, OTHER THAN NOMINAL PRINTING, USING PRINT PASTE CONTAINING DISCHARGE MATERIAL, RESIST MATERIAL, OR DYE MATERIAL; OR STENCIL DYEING
407	...With dye other than oxidation dye		.Resist or reserve
408	...Plural dyes or dye and coupling agent	446	..Wax
409Heterocyclic amine dye	447	..Chemically modified local areas
410Paradiaminobenzene dye	448	..Reactive dye
411With metadiaminobenzene dye	449	..Oxidation dye, e.g., aniline, nitroaniline, etc.
412With aminophenol dye	450	..Azo dye component ground
414Nitroaniline dye	451	..Mordant dye, e.g., dye with a metal chelating group, etc.
415Nitrophenylenediamine dye	452	..Vat dye or sulfur dye, e.g., quinonic or indigoid reducible dye, sulfur organic reaction product dye, etc.
416Aryldiamine dye		..Basic dye, including diphenylmethane, triphenylmethane, xanthene, fluorene, methine, acridine, oxazine, phenazine, flavylium, naphthoperinone, quinophthalone, quaternary ammonium group, etc., containing
421Aminophenol dye		..Acid (including direct) dye, e.g., sulfonated, sulfamated, etc.
423Aminoheterocyclic dye		..Disperse dye
424Phenols (natural oxidation dye)	453	.Discharge utilized
425	..Mordant, solvent dye formation or metallized azo dye	454	..Chemically modified local areas
426	..Basic dye, including diphenylmethane, triphenylmethane, xanthene, fluorene, methine, acridine, oxazine, phenazine, flavylium, naphthoperinone, quinophthalone, quaternary ammonium group, etc., containing	455	..Oxidation dye, e.g., aniline, nitroaniline, etc.
428	..Dye reactive with hair		..Mordant dye
429	..Developed on the hair		
431	..With fluid treatment, e.g., bleaching with dyeing, etc.	456	
432	...-S-S- bond disruption, e.g., use of thioglycolates, etc.	457	
433	...Swelling of hair	458	
435	..Solvent assisted dyeing	459	
436	.Leather dyeing		
437	..Azo dye		
438	PROCESS OF EXTRACTING OR PURIFYING OF NATURAL DYE	460	